

REMARKS:

Entry of the foregoing and reexamination and reconsideration of the subject application, as amended, and in light of the remarks that follow, are respectfully requested.

Claims 1-34 are pending in the application. Claim 3 is objected to because of an informality. Applicants have amended Claim 3 to address the Examiner's objection. Claims 22, 25-26 and 30 are rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to point out and distinctly claims the subject matter which the applicant regards as the invention. Applicants disagree, but have amended Claims 22, 25-26 and 30 to address the Examiner's concerns.

Claim 22 is rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. The Examiner asserts:

Applicant is claiming a "lens" but is then claiming zero optical power which is inconsistent rendering the claim vague and indefinite. A lens will inherently by definition either converge or diverge light and therefore will inherently have an optical power.

See Detailed Action, page 3. Applicants respectfully traverse the Examiner's conclusion and rejection. It is well known by those of ordinary skill in the art that a lens may be made having no optical power. An example is a plano lens. These lenses are often prescribed in situations where an individual may have a refractive error requiring correction in one eye, but not the other. The plano lens is prescribed for the eye not requiring correction and has no optical power. *See*, <http://www.lasermyeye.org/encyclopedia/plano.html>.

Claims 1-4, 11-12, 16-17, 20, 23, 26, and 29-30 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,712,721 to Large. (the "Large Patent"). Claims 1-2, 11-12, 21, 23 and 26 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,300,818 to Schachar (the "Schachar Patent"). Claims 1-2, 11-12, 19-20 and 22 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S Patent No. 5,184,156 to Black et al (the "Black Patent").

Claims 5-10 are rejected under 35 U.S.C. § 103(a) as allegedly obvious considering the Schachar Patent in view of U.S. Patent No. 6,213,602 to Smarto (the "Smarto Patent"). Claims

13-14 are rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over the Schachar Patent in view of U.S. Patent No. 6,099,117 to Gregory (the “Gregory Patent”). Claims 17-18 and 20 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Schachar Patent. Claim 19 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Large Patent. Claim 25 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Schachar Patent in view of Nishioka Publication No. 2004 / 0179280. Finally, Claim 27 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Schachar Patent in view of U.S. Patent No. 5,359,444 to Piosenka (the “Piosenka Patent”).

By the present amendment, claims 1-3, 15, 17,-22, 24-26, and 28-30 have been amended. New claims 31-34 have been added. Applicants respectfully submit that the present amendments contain no new subject matter, and are supported by the original specification.

Applicants respectfully request reconsideration of the pending claims in view of the foregoing amendments and the remarks that follow, and submits that all are in condition for allowance.

I. THE CLAIMS DEFINE PATENTABLE SUBJECT MATTER

A. Rejections under 35 U.S.C. § 102(b) in light of the Large Patent

In the present Office Action, the Patent Office rejected Claims 1-4, 11-12, 16-17, 20, 23, 26, and 29-30 under 35 U.S.C. § 102(b) as allegedly anticipated by the Large Patent. Applicants respectfully traverse these rejections and assert that the claims are in condition for allowance.

1. Independent Claim 1

Amended Claim 1 recites “wherein the electro-active element comprises a plurality of pixels.” The Large Patent teaches an electro-active lens assembly using liquid crystal. However, the Large Patent does not teach how an electro-active lens may be manufactured wherein the electro-active element comprises a plurality of pixels. The Large Patent does not disclose the use of pixels at all.

Therefore, Applicants respectfully submit that Claim 1 is in condition for allowance, and that the rejection of Claim 1 should be withdrawn. In addition, Claims 2-4, 11-12, 16-17, 20, 23 and 26 that variously depend from Claim 1, are also in condition for allowance and these

rejections should be withdrawn as well. For similar reasons, new Claims 31-34 are in condition for allowance.

2. Independent Claim 29

Similarly, amended Claim 29 recites “an electro-active element containing a plurality of pixels within the recess of the lens blank surface. Because the Large Patent does not teach the use of pixels, this recitation is not disclosed.

Therefore, Applicants respectfully submit that Claim 29 is in condition for allowance, and that the rejection of Claim 29 should be withdrawn. In addition, Claim 30, that depends from Claim 29, is also in condition for allowance and the rejection should be withdrawn as well.

B. Rejections under 35 U.S.C. § 102(b) in light of the Schachar Patent

Claims 1-2, 11-12, 21, 23 and 26 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by the Schachar Patent. Applicants respectfully traverse these rejections and assert that the claims are in condition for allowance.

1. Independent Claim 1

Likewise, amended Claim 1 recites “wherein the electro-active element comprises a plurality of pixels.” The Schachar Patent discloses a multifocal ophthalmic lens including liquid crystal film for varying the power of the lens. However, the Schachar Patent does not teach the use of pixels in its electro-active lens.

Therefore, Applicants respectfully submit that Claim 1 is in condition for allowance, and that the rejection of Claim 1 should be withdrawn. In addition, Claims 2, 11-12, 21, 23 and 26 that variously depend from Claim 1, are also in condition for allowance and these rejections should be withdrawn as well. For similar reasons, new Claims 31-34 are in condition for allowance.

C. Rejections under 35 U.S.C. § 102(b) in light of the Black Patent

Finally, Claims 1-2, 11-12, 19-20 and 22 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by the Black Patent. Applicants respectfully traverse these rejections and asserts that the claims are in condition for allowance.

1. Independent Claim 1

Amended Claim 1 recites “wherein the electro-active element comprises a plurality of pixels.” The Black Patent discloses glasses with color-switchable, multi-layered lenses, but does not teach the use of pixels in its lens.

Therefore, Applicants respectfully submit that Claim 1 is in condition for allowance, and that the rejection of Claim 1 should be withdrawn. In addition, Claims 2, 11-12, 19- 20 and 22 that variously depend from Claim 1, are also in condition for allowance and these rejections should be withdrawn as well. For similar reasons, new Claims 31-34 are in condition for allowance.

D. Rejections under 35 U.S.C. § 103

Claims 5-10 are rejected under 35 U.S.C. § 103(a) as allegedly obvious considering the Schachar Patent in view of the Smarto Patent. Claims 13-14 are rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over the Schachar Patent in view of the Gregory Patent. Claims 17-18 and 20 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Schachar Patent. Claim 19 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Large Patent. Claim 25 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Schachar Patent in view of Nishioka Publication No. 2004 / 0179280. Finally, Claim 27 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over the Schachar Patent in view of the Piosenka Patent.

Because no individual piece of prior art teach the use of pixels in an electro-active lens, no combination of the prior art can render the amended claims unpatentable. Accordingly, Applicants respectfully submit that the amended claims are in condition for allowance, and that the rejections under 35 U.S.C. § 103 should be withdrawn.

CONCLUSION:

Applicants respectfully submit that all pending claims are in condition for allowance. Should the Examiner determine that any further action is necessary to place the claims in condition for allowance, the Examiner is kindly requested (and encouraged) to telephone the Applicants’ undersigned representative at the number listed below.

Attorney Docket No. 63049.000088
Attorney Customer No. 27682

Respectfully submitted,
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